

## REMARKS/ARGUMENTS

Responsive to the Office Action mailed October 20, 2004:

### I. NON-PRIOR ART MATTERS

- A. The Office Action required an election of the invention to be examined.

Applicant herein confirms the election of Group I, comprising claims 1-22.

### II. PRIOR ART MATTERS

- A. The Office Action rejected claims 1, 3, 5, 7 and 20-22 under 35 USC 102(b) as being anticipated by Greenwell. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.<sup>1</sup>

As to amended claim 1, Greenwell does not disclose an air flow control mechanism controlling the volume of heated air passing through the second apertures, further comprising a variable speed fan. The air flow in Greenwell is driven by a butterfly valve 626 (see Fig. 23, providing mass flow).

Claim 1 is therefore allowable.

Claims 3, 5, 7, and 21-22 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Furthermore as to claim 3, Greenwell does not disclose first apertures and second apertures in substantial alignment as the conveyor moves along the first direction. The apertures 719 through which the heated air moves from the heated air plenum are inclined at an angle to the apertures between rollers 704. See Figs. 1a and 26.

Further as to amended claim 7, Greenwell does not disclose at least two side-by-side conveyors running along the first direction.

---

<sup>1</sup> *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

Claim 20 has been cancelled and its limitations incorporated into claim 1.

- B. The Office Action rejected claims 2, 4, 6 and 10-14 under 35 USC 103(a) as being unpatentable over Greenwell. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>2</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>3</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>4</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations.

The Examiner has made a blanket rejection of the claims without providing any reference to support the rejection other than Official Notice. Officially noticed facts may only play a minor role in filling evidentiary gaps and cannot provide the totality of evidence to support a rejection.<sup>5</sup> The Examiner's assumptions do not constitute the disclosure of prior art.<sup>6</sup> Applicant takes issue with the Examiner's official notice and contends that the Office Action is ignoring

---

<sup>2</sup>MPEP Sec. 2142.

<sup>3</sup> Id.

<sup>4</sup>Id. (emphasis supplied)

<sup>5</sup> *In re Samuel S. M. Sun, et.al.*, Appeal No. 93-1261 (Fed. Cir., Dec. 23, 1993), citing *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970).

<sup>6</sup> *In re Rijckaert*, Appeal No. 93-1206 (Fed. Cir., Nov. 23, 1993)

claim elements and limitations which can only be construed to mean official notice without enablement under the prior art reference. Such a rejection is legal error.

Further as to claim 14, the Office Action states that "the size of the apertures depends upon the desired air flow and would have been obvious to one skilled in the art to experiment to reach the optimum desired flow." The Federal Circuit has held that

"'Obviousness to experiment' is not a proper standard for obviousness. Selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure."<sup>7</sup>

Thus, the rejection of claim 14 is improper.

Furthermore, the rejected claims contain additional elements or limitations beyond allowable claim 1 and are also allowable.

C. The Office Action rejected claims 7-9, 15, 16, 18 and 19 under 35 USC 103(a) as being unpatentable over Greenwell in view of Neagle. Applicant respectfully traverses the rejection.

The rejected claims contain additional elements or limitations beyond allowable claim 1 and are therefore also allowable.

Further, the Examiner has not shown where either reference discloses a film separator as claimed in claims 18 and 19 and defined in the Specification at p. 14, lines 1-8.

New claims 53-55 are patentable over the cited prior art.

As to claim 53, Greenwell (Col. 13, lines 44-50), the volume control means 618 consists of a plurality of adjustable vanes 619 disposed transversely across the items to be shrink-wrapped, so that there is no way to direct the air flow from the vanes 619 at specific, designated portions of the article. See also Fig. 21.

---

<sup>7</sup> *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988)


As to claim 54, the adjustable vanes 619 of Greenwell are substantially perpendicular to the direction of movement of the conveyor, not substantially parallel thereto.

As to claim 55, the masking pads 308 and 607 of Greenwell "are parts of the continuously moving endless conveyor 601" (Col. 14 lines 25-27), and are not fixed baffles as claimed. The claimed baffles are of much simpler construction. Furthermore, the masking pads 308 and 607 of Greenwell cannot be adjusted to block air directed at less than the entire bottom surfaces or top surfaces of each package group 209 (Col. 14, lines 11-16). In contrast, the fixed baffles 264 of the present invention can be independently adjustable to selectively block air flow across each air lane 262 (see p. 14 lines 15-23).

In summary, Greenwell controls the volume of heated air over the entire articles to be shrink-wrapped, whereas the present invention specifically directs heated air only at areas of the package to be weakened, and does so in a much simpler manner than Greenwell.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

By   
Nelson R. Capes (Reg. No. 37,106)  
Gerald E. Helget (Reg. No. 30,948)  
Briggs & Morgan P.A.  
80 South Eighth Street  
2200 IDS Center  
Minneapolis, MN 55402  
Telephone: (612) 977-8486